

## **REMARKS**

Claims 20-40, 47-61, and 68-162 are pending with claims 29-34, 40, 47-61, and 68 being elected. Claims 29-30, 39-40, 47, and 68 have been amended. It is pointed out that while the Office Action indicated that claim 39 was withdrawn, the Office Action nonetheless rejected claim 39. Accordingly, Applicant treats claim 39 as not being withdrawn and responds to the rejection of this claim below.

While as they stood the input receptacle, single output receptacle, and the transport mechanism limitations of claim 29 did not invoke 35 U.S.C. § 112, ¶ 6, “for receiving” has been changed to “adapted to receive” and “for transporting” has been changed to “adapted to transport” to further clarify that the input receptacle, single output receptacle, and the transport mechanism limitations do not invoke 35 U.S.C. § 112, ¶ 6. Similar amendment are made in claim 30. In claims 39 and 40, “for receiving” has been changed to “positioned to receive” and “for transporting” has been changed to “adapted to transport” also to further clarify that 35 U.S.C. § 112, ¶ 6 has not been invoked. These amendments do not narrow the scope of the claims.

Furthermore, Applicant notes that where Applicant desires to invoke 35 U.S.C. § 112, ¶ 6, the phrases “means for” or “step for” are recited verbatim. Conversely, and to aid the public notice function of the claims, any limitation not explicitly using either the phrase “means for” or “step for” is not a limitation under 35 U.S.C. § 112, ¶ 6.

In claims 29, 30, 39, and 40 “evaluating” has been changed to “processing” and “evaluated” has been changed to “processed.” In claim 47, “evaluated” has been changed to “processed” and in claim 68 “evaluate” has been changed to “process” and “evaluated” has been changed to “processed.” These amendments do not narrow the claims.

In claim 39, the last two wherein clauses have been incorporated into earlier paragraphs; and hence, these amendments do not narrow the claims.

As it stood, claim 40 referred to documents and the last wherein clause referred to U.S. currency bills. The restriction requirement dated September 25, 2003 restricted out claims directed to the evaluation of documents. Accordingly, to clarify that claim 40 is compliant with the September 25, 2003 restriction requirement while improving readability, claim 40 has been

amendment to change references to “documents” to “U.S. currency bills” or “bills” and references to “document types” have been changed to “denominations.”

## **I. Restriction Requirement**

In the Amendment and Response to Election Requirement of December 8, 2003 dated February 6, 2004, Applicant respectfully requested that the grouping of claims 82-162 be identified or clarified by the Patent Office. Applicant notes that the current Office Action dated March 18, 2004 did not address the classification of these claims. Accordingly, Applicant respectfully again requests that the Patent Office please classify these claims. Doing so will facilitate the Applicant’s ability to file the appropriate number of continuing or divisional applications, each containing the appropriate grouping of claims should these claims not be eventually considered in the present application. Along these lines, Applicant’s remarks contained in the Amendment and Response to Election Requirement of December 8, 2003 dated February 6, 2004 are incorporated herein by reference.

## **II. Information Disclosure Statements**

The Office Action states that the Information Disclosure Statements (IDSs) filed February 19, 2002 and February 9, 2004 failed to comply with 37 CFR 1.98(a)(2) which requires that a legible copy of each reference to be submitted. While the Office Action states that the IDSs have been placed in the file but the information referred to therein has not been considered, the Office Action then goes on to state that in fact all US references have been considered.

With respect to the IDS dated February 19, 2002, as stated in that IDS it is believed that the IDS is compliant with 37 CFR 1.98 as copies had been submitted in connection with an earlier application pursuant to 37 CFR 1.98(d) as that rule existed on February 19, 2002. Nonetheless, necessary copies will be provided along with the re-submission of the February 19, 2002 IDS. Applicant understands from the Office Action the citations to references A1-A137 are being held to be compliant with rule 37 CFR 1.98(a)(2) and hence copies of these references will not be submitted. Applicants note that the Form PTO-1449 has been also initialed for foreign references B1-B36 and therefore presumably the citation to these references has also been found to be acceptable. However, the Office Action does not clearly say that in connection

with paragraph 3. It seems likely that parts of paragraph 4 are also meant to apply to paragraph 3 and the February 19, 2002 IDS but Applicant is not positive. Accordingly, copies of foreign references B1-B36 and other references C1-C60 will accompany the re-submission of the IDS dated February 19, 2002.

With respect to the IDS mailed on February 6, 2004, copies of all references are believed to have been submitted with that, and hence, this IDS is believed to be compliant with 37 CFR 1.98(a)(2). Nonetheless, necessary copies will be provided along with the re-submission of the February 19, 2002 IDS. Applicant understands from the Office Action the citations to references E1-E80, F2-F10, F13, and F17 and G134 and G138 are being held to be compliant with rule 37 CFR 1.98(a)(2) and hence additional copies of these references will not be re-submitted. However, the Office Action indicates that copies of foreign references F1, F11, F12, F14, F15, and F16 along with their translations (G133, G135, G136, abstract for F14, G137, and the abstract for F16) are desired. Rather than re-submitting copies of these references with the re-submission of the IDS dated February 6, 2004, Applicants points out that these references and their translations or abstracts may be found in the Cummins-Allison Library located at the Patent and Trademark Office at PK5-5T11 as references: C-C2; C-C25; C-C28; C-C38; C-C39; and C-C43.

The front pages of the following “other” references were attached to the Office Action:

G3, G5-G7, G9, G15, G18-G20, and G25-G29.

Rather than re-submitting copies of these references with the re-submission of the IDS dated February 6, 2004, Applicants points out that these references may be found in the Cummins-Allison Library located at the Patent and Trademark Office at PK5-5T11 as references: CD3, CD5-CD7, CD9, CD15, CD18-CD20, and CD25-CD29, respectively.

Furthermore, as was done in the IDS dated February 6, 2004, it is pointed out that on October 1, 2002, Cummins-Allison Corp., assignee of the present application, sued Glory Ltd., Glory Shoji Co. Ltd., and Glory (U.S.A.), Inc., in the United States District Court for the Northern District of Illinois, Civil Action No. 02C-7008 (complaint listed as ref. G1) for infringement concerning U.S. Pat. No. 6,459,806. The documents listed on the attached Form PTO-1449 as refs. G1-G94 are from this litigation. Accordingly, pursuant to 37 C.F.R. §1.98(3)(i), the relevance of any non-English references listed on the attached Form PTO-1449

from G1-G94 is that such references were identified by Glory in the above mentioned litigation. Accordingly, the relevance of references G3, G5-G7, G9, G15, G18-G20, and G25-G29 is that they were identified by Glory in the above mentioned litigation. More specifically, references G3, G5-G7, and G9 were attached to the declaration of Mr. Mouri (G2), reference G15 was attached to the declaration of Mr. Uesaka, references G18-G20 were attached to the declaration of Mr. Hoyo, and references G25-G29 were attached to the declaration of Mr. Dolsen.

Because copies of the front pages of the remaining “other” references did not accompany the Office Action, Applicant assumes that the citation to these references has been found to be compliant with 37 CFR 1.98(a)(2); and hence, additional copies of these references will not be re-submitted.

### **III. Drawings**

Applicant acknowledges the acceptance of the 6 sheets of formal drawings submitted on February 19, 2002.

### **IV. Objection to and Rejection of Claims 48 and 59**

In the Office Action dated March 18, 2004, claims 48 and 59 were objected to “as being of improper dependent form for failing to further limit the subject matter of a previous claims.” Claims 48 and 59 were also rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite. Both of these actions appear to be based on the premise that claims 48 and 59 somehow expand rather than limit the subject matter of a previous claim. Applicant does not agree that claims 48 and 59 are not further limited in scope than the claim 47 from which they depend. Both claims 48 and 59 recite the additional limitation of an “act of halting the transporting of” bills, a limitation not found in independent claim 47. Accordingly, dependent claims 48 and 59 are more limited in scope than claim 47.

The objection and rejection of claims 48 and 59 appear to stem from the Examiner’s objection to the act of flagging as including an action such as by stopping the machine. This objection stems from the Examiner’s understanding the noun “flag” for which the Office Action offers one definition.

First, Applicant agrees that the noun flag includes, for example, a bit. However, Applicant notes that the noun flag is not as limited as recited in the Office Action. For example, Webster's New World Dictionary of Computer Terms, 4<sup>th</sup> Edition, ©1992 defines "flag" as follows:

**flag (1)** An indicator used frequently to tell some later part of a program that some condition occurred earlier, such as an overflow or carry. **(2)** A symbol used to mark a record for special attention. For example, on a listing of a program, all statements that contain errors may be flagged for the attention of the program writer. **(3)** An indicator of special conditions, such as interrupts.

Accordingly, the noun flag in computer science is not necessarily limited to a single bit or to a binary value.

Secondly, Applicant respectfully points out that the term which has been objected to in claim 47 is a verb, an action, namely, the act of "flagging". Apparently, the Office Action interprets the act of flagging as being limited to the act of setting a flag and excluding any other action. While Applicant agrees that the act of flagging may involve the act of setting a flag, contrary to the Office Action, the act of flagging does not necessarily exclude alternative or additional actions. A review of the specification makes this clear. For example, the specification states, inter alia, "According to one embodiment, the evaluation device flags no call bills by stopping or halting the transport mechanism." Page 4, lines 12-13 (underlining added). Similar, the specification states, inter alia:

According to one embodiment, the evaluation device flags bills meeting or failing to meet certain criteria, such as being suspect bills, by stopping or halting the transport mechanism. For example, the transport mechanism may be stopped so that the flagged bill is at an identifiable location, such as being the last bill in the output pocket.

Page 4, lines 23-26 (underlining added). Additionally, the specification states, inter alia:

Another advantage accruing from the reduction in processing time realized by the above sensing and correlation scheme is that the response time involved in either stopping the transport of a bill that has been identified as "spurious", *i.e.*, not corresponding to any of the stored master characteristic patterns, or diverting such a bill to a separate stacker bin, is correspondingly shortened. Accordingly, the system can conveniently be programmed to set a flag when a scanned pattern does not correspond to any of the master patterns. The identification of such a condition can be used to stop the bill transport drive motor for the mechanism.

Page 35, lines 13-20 (underlining added). Accordingly, the specification makes clear that the act of flagging may comprise alternative or additional acts to the act of setting a flag such as, for example, the act of stopping the transport mechanism and the act of diverting a bill to a different location.

Furthermore, dictionary definitions support this understanding the term “flag”. For example, The American Heritage Dictionary, Second College Edition © 1991 defines “flag”, inter alia, as follows: “*tr. v. flagged, flag-ging, flags* 1. To mark with a flag for identification or ornamentation. 2. a. To signal with or as if with a flag. b. To signal to stop.” The same dictionary defines “mark”, inter alia, as follows: “to distinguish, indicate, or characterize; to set off or separate by or as if by a mark.” That dictionary defines “distinguish” as, inter alia: “to recognize as being different or distinct; to perceive distinctly, make out; to detect or recognize, pick out, to make noticeable or different, set apart” and defines “indicate” as, inter alia: “to demonstrate or point out.” Accordingly, “flagging a bill” is a broad but definite expression which while it may include the action of setting a bit, it is not necessarily so limited. Rather it is clear that to “flag a bill” means to distinguish a bill or make a bill distinguishable or to set it apart or to point it out. Thus, for example, the act of setting a bit, the act of halting, and/or the act of diverting serve to distinguish a bill from bills for which such actions are not taken and hence these actions may all properly be referred to as acts of flagging.

Accordingly, claims 48 and 59 are believed to be allowable.

## **V. 35 U.S.C. §103 Rejections**

### **A. Claims 29-34, 40, 47, 61 and 68: Lee and Hatanaka**

Claims 29-34, 40, 47, 61 and 68 were rejected under 35 U.S.C. § 103(a) based on Lee (US 4,973,851) in view of and Hatanaka et al. (JP 54-71673).

These rejections are respectfully traversed at least because neither Lee nor Hatanaka teaches a currency evaluation device having “a single output receptacle adapted to receive said bills after said bills have been processed” (claim 29); “a single output receptacle positioned to receive bills after the bills have been processed” (claim 68) or “transporting...the bills ... to a single output receptacle” (claim 47). Although the Office Action initially asserts that Lee has a single output receptacle (page 5 of Office Action), the Office Action later recognizes that such is

not the case as Lee expressly teaches that processed bills may be directed to at least two different destinations, namely, stacker 14 of Fig. 1 and the inlet (see Lee col. 15, ll. 50-55 and Office Action page 5. That is, in Lee bills are not all directed to a single output receptacle, but rather, reject bills are sent to a separate location, namely, back to the inlet.

Similarly, Hatanaka discloses a device having at least two destinations for bills. Fig. 3 discloses the control circuit for the device disclosed in Hatanaka (see translation page 7, line 9 and page 14, lines 2-3). The control circuit has a wrong denomination paper discharge unit 123 (translation page 7, line 26 and Fig. 3). “If a mismatch is indicated by the collation signals RF from the denomination collation unit 114, the detected note of paper currency is not conveyed to the paper currency collection platform 23 but may be discharged from a discharge slot.” (translation page 7, line 26 – page 28, line 1). Accordingly, the device of Hatanaka clearly has at least two destinations for processed bills, namely, platform 23 and a discharge slot.

Accordingly, neither Lee nor Hatanaka nor the combination thereof teach the “single output receptacle” recited in the rejected claims and hence claims 29-34, 40, 47, 61 and 68 are allowable.

Applicant points out and reserves the right to further explain, if necessary, that Lee and Hatanaka are not properly combinable as it is clear that Lee is directed to the non-analogous art of vending machines and bill changers (Lee col. 1, ll. 9-10) which are very slow, one bill at a time machines as opposed to devices which can accept and rapidly process an entire stack of bills.

Likewise, Applicant reserves the right to address the other statements made in the Office Action in conjunction with the rejection of claims 29-34, 40, 47, 61 and 68 based on Lee and Hatanaka, if necessary. For example, the Office Action states that Hatanaka discloses “the scanning comprising reflecting of light on one side of the bill to discriminate the denominations of bills.” (Office Action, page 7, ¶17). A review of Figure 4 of Hatanaka shows the use of transmitted light, not reflected. However, because of the above described “single output receptacle” distinction, the claims are believed to be allowable and hence no further comments are believed necessary. Accordingly, it is pointed out that Applicant’s silence with respect any other statements in the Office Action are not to be interpreted as acceptance of such statements.

**B. Claims 33, 34, 39, 52, 53, 56 and 57: Raterman**

Claims 33, 34, 39, 52, 53, 56, and 57 were rejected under 35 U.S.C. §103(a) as being obvious over Raterman et al. The Office Action does not recite the patent number of Raterman and the accompanying form PTO-892 does not list Raterman. The form PTO-892 does, however, mention U.S. Patent No. 5,925,196 and lists the inventors as Bevilacqua et al. Moreover, although not listed in the form PTO-892, a copy of U.S. Pat. No. 5,295,196 to Raterman et al. accompanied the Office Action. Therefore, Applicant assumes that the form PTO-892 contains a typographical error and that “5,925,196” is meant to be “5,295,196” to Raterman et al. and that the Raterman reference referred to in the Office Action is U.S. Pat. No. 5,295,196.

The present application and U.S. Pat. No. 5,295,196 to Raterman et al. were, at the time the inventions of the present application were made, owned by or subject to an obligation of assignment to Cummins-Allison Corp. In support thereof, attached please find the assignments filed in connection with U.S. Pat. No. 5,295,196 to Raterman et al. which issued from U.S. patent application Serial No. 07/885,648; U.S. Pat. No. 6,220,419 issuing from U.S. patent application Serial No. 08/834,746; and U.S. Pat. No. 5,815,592 issuing from U.S. patent application Serial No. 08/340,031.

Accordingly, Raterman is not prior art with respect to claims 33, 34, 39, 52, 53, 56, and 57. MPEP § 706.02(l)(1) and (l)(2).

**C. Claims 33, 34, 39, 52, 53, 56 and 57: Lee, Hatanaka, and Curl**

Claims 33, 34, 39, 52, 53, 56 and 57 were rejected under 35 U.S.C. § 103(a) based on Lee in view of Hatanaka et al. and further in view of Curl et al. (US 4,592,090).

These rejections are respectfully traversed. As discussed above, neither Lee nor Hatanaka nor the combination thereof teach the “single output receptacle” recited in claims 33, 34, 39, 52, 53, 56 and 57. Curl likewise fails to teach the “single output receptacle” recited in claims 33, 34, 39, 52, 53, 56 and 57 and hence claims 33, 34, 39, 52, 53, 56 and 57 are allowable at least because as none of the cited references teach or suggest such a limitation.

Moreover, it is pointed out that Curl discloses that a banknote to be scanned must be mouted on a rotating drum. (Curl, col. 4, ll. 29-30). Accordingly, such an arrangement would



permit a sensor (see sensor arrangement of Fig. 3) to be positioned only adjacent to one surface of a bill (the surface not adjacent to the drum) and not both as recited in the recited claims, see *e.g.*, claim 29 (“two detectors positioned along said transport path between said input receptacle and said output receptacle, said detectors being disposed on opposite sides of said transport path so as to be disposed adjacent to first and second opposing surfaces of said bills”). Likewise, having to mount and subsequently remove a bill and then mount and remove another bill from the drum would preclude the ability to determine the denominations of a stack of bills at the recited rates of 800 and 1000 bills per minute. Furthermore, there is no teaching or suggestion that either Lee or Hatanaka are capable of denominating bills at the recited rates of 800 and 1000 bills per minute. In this connection, Applicants traverse the statements in paragraph 16 of the Office Action and respectfully request that such statements be withdrawn as lacking both legal and factual bases.

Accordingly, claims 33, 34, 39, 52, 53, 56 and 57 are believed to be allowable.

Conclusion

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. A check in the amount \$110.00 is enclosed for the one-month extension of time. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47171-00300USC2.

Respectfully submitted,



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